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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,621	02/04/2004	Craig A. Schmitt	00635-234001	9508
26161	7590	09/09/2005	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			HOOK, JAMES F	
			ART UNIT	PAPER NUMBER
			3754	

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/771,621

Applicant(s)

SCHMITT, CRAIG A.

Examiner

James F. Hook

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2-24-05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

Applicant's acknowledgement of the election of group II in the reply filed on June 13, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). There is no discussion of the supposed errors in the recently received amendment, and since the current examiner of record was not the person applicant's representative talked to when electing the group and any arguments stated at that time, it is impossible to consider any traversal at this time, and therefore such will be considered an improper traversal at this time.

### *Double Patenting*

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 24-26 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 17, 19, and 20 of copending Application No. 10/987,445. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

It is noted that a divisional application No. 11/104,748 has been filed and has the same claimed subject matter as the withdrawn claims 1-16 of the instant application. Since these claims are withdrawn from further consideration, a rejection of these claims under 35 U.S.C. 101 is not necessary at this point, however, should withdrawn claims 1-16 of the instant application ever be reinstated, they would be subject to a rejection under 35 U.S.C. 101 unless such are canceled in the instant application.

***Response to Amendment***

The amendment filed June 13, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the addition of the word "an" to give antecedent basis to the limitation of "said insert" in claim 20, by adding antecedent basis to this limitation, it now requires the plug to be made of a first material and a second material, however, the specification supports only a one piece plug of a first softer material and a housing or insert of second material, it does not state that the plug itself is formed of two different parts and materials, nor does it suggest that once combined with the limitations of independent claim 17 which positively recites a housing, and a plug, and then claim 20 further states the plug is two parts, that would lead to a three piece structure of a housing, a plug, and an insert which has two parts of the plug made of different material which does not appear to be supported by the specification. The word "or" when describing the member 125 as being a housing or an insert is not the same as stating that there is an insert in addition to the housing,

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therefore there is no antecedent basis for forming the restrictor of a housing, plug, and insert, where the plug is formed of two different materials and parts.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 20 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As set forth above, the limitation in claim 20, line 2, setting forth "an insert" in addition to the plug and housing structure is not supported by the original specification as set forth above, where further there is no suggestion the plug is formed of two parts made of different materials.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17-19 and 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Waller. The patent to Waller discloses the recited flow restrictor defining

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a restricted flow path comprising a housing 12 defining an elongated conduit having a tapered conical wall defining a first screw thread 28,30 between a first and second opening for fluid flow, an axially elongated plug 32 is received in the conduit, a surface of the plug opposed to the tapering conical wall defines a second screw thread and a tapering surface, the second screw thread is in threaded engagement with the first screw thread, where fluid can flow through the gap between the screw threads thereby inherently creating a fluid channel, where the use of water is merely intended use where the apparatus of Waller is capable of use with water, the threaded channel is spiral and extends from the first opening to the second opening, the plug is received through the second opening, the limitation of how the plug and housing are formed is merely a method limitation which appears to provide no patentable weight to the article in that it is not clear that such method would change the final article or how it functions, where the channel formed by the plug and housing creates a port along with the exit opening.

Claims 17-19 and 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith. The patent to Smith discloses the recited flow restrictor defining a restricted flow path comprising a housing 12 defining an elongated conduit having a tapered conical wall defining a first screw thread 72 between a first and second opening for fluid flow, an axially elongated plug 34 is received in the conduit, a surface of the plug opposed to the tapering conical wall defines a second screw thread and a tapering surface, the second screw thread is in threaded engagement with the first screw thread, where fluid can flow through the gap between the screw threads thereby inherently creating a fluid channel, where the use of water is merely intended use where the apparatus of Waller is capable of use with water, the threaded channel is spiral and extends from the first opening to the second opening, the plug is received through the second opening, the limitation of how the plug and housing are formed is merely a method limitation which appears to provide no patentable weight to the article in that it is not clear that such method would change the final article or how it functions, where the channel formed by the plug and housing creates a port along with the exit opening.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waller in view of Bryant. The patent to Waller discloses all of the recited structure

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with the exception of forming the threads as a pointed protrusion that penetrates the tapered surface. The patent to Bryant discloses the recited restrictor comprising a housing 17 which can be seen to have a conical wall in figure 3 where a plug 16 is provided therein, and has screw threads 20a which can be seen to penetrate the conical wall surface and thereby such has threads also. It would have been obvious to one skilled in the art to modify the plug of Waller to have any shape threads including pointed where such is merely a choice of mechanical expedients and an obvious alternate shape of threads on threaded plugs in restrictors, and allow the threads to penetrate the surface where such would provide for better control of flow as suggested by Bryant and would increase the efficiency of the plug and thereby inherently save money.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Waller or Smith in view of Pett. The patents to Waller and Smith disclose all of the recited structure with the exception of forming a gap in the threads of the plug to allow for alternate flow paths. The patent to Pett discloses that it is old and well known in threaded restrictors to provide a gap in threads to thereby form a second and third thread on the plug and allow for a different flow pattern. It would have been obvious to one skilled in the art to modify the plug in Smith or Waller by providing a gap in the threads of the plug to create second and third threaded portions as suggested by Pett where such would change the flow characteristics of the restrictor and allow for a greater range of uses thereby saving money.

***Response to Arguments***

Applicant's arguments filed June 13, 2005 have been fully considered but they are not persuasive. The arguments merely set forth claim language and sections of the references, but fails to disclose why the references themselves and the manner in which the examiner interpreted and applied them is in error, therefore such is not considered to be consistent with the requirements of 37 CFR 1.111 (b). Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Merely setting forth claim language and a section of the prior art but not relating the two to one another and explaining why the reference does not read on the claim limitations in the manner the examiner set forth is not considered to be specific. Since there are no specific arguments set forth the examiner cannot address them at this time, and still feels the prior art references read upon the claim limitations as set forth above.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The reference to Olson disclosing a state of the art restrictor structure.

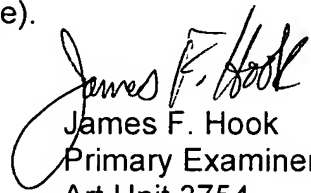
**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James F. Hook whose telephone number is (571) 272-4903. The examiner can normally be reached on Monday to Wednesday, work at home Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Mar can be reached on (571) 272-4906. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
James F. Hook  
Primary Examiner  
Art Unit 3754

JFH